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EXAMINER

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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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*Ex parte* RANDALL A. ADDINGTON, W. ROBERT  
ADDINGTON, and W. ROBERT ADDINGTON II

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Appeal 2008-6218  
Application 09/396,531  
Technology Center 3700

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Decided:<sup>1</sup> April 14, 2009

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Before ERIC GRIMES, MELANIE L. McCOLLUM, and  
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

## DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a bowler's finger pad shield. We have jurisdiction under 35 U.S.C. § 6(b). We affirm-in-part.

### *Statement of the Case*

#### *Background*

“Attempts to assist or aid the bowler in the delivery of the bowling ball have used various means to support or position the wrist or fingers” (Spec. 2).

#### *The Claims*

Claims 33-58 are on appeal. We will focus on claims 33, 34, 36-38, 40, 42, 43, and 49 which are representative and read as follows:

33. A bowler's finger pad shield for protecting a finger pad from the force produced when applying lift to a bowling ball, to rotate or spin the ball at its release, comprising:

a) a finger pad shield with an open end adapted for insertion of a finger pad, said finger pad shield including a first surface and a second surface, extending from said open end; said first surface including a contact area located proximate said open end and positioned relative to said open end to receive a finger pad;

c) [sic] said second surface is opposed to said first surface;

d) [sic] said finger pad shield is adapted for insertion into the finger hole of a bowling ball, to place said second surface in contact with a bowling ball finger hole; and wherein

e) [sic] said finger pad shield includes at least one fastener to hold said contact area in a fixed relationship with a finger pad; wherein a force produced in the release and lifting of the bowling ball, is spread over said contact area.

34. The bowler's finger pad shield of claim 33, wherein said at least one fastener is a strap.

36. The bowler's finger pad shield of claim 33, wherein said at least one fastener is a ring.

37. The bowler's finger pad shield of claim 33, wherein said fastener is an enclosure for a finger and said finger pad shield is attached to said enclosure.

38. The bowler's finger pad shield of claim 33, wherein said finger pad shield includes a raised surface for contacting the surface of a bowling ball; said raised surface is located proximate said open end and adapted to limit the depth of insertion of said finger pad shield into the finger hole of a bowling ball.

40. A bowler's aid for assisting a bowler in applying the a [sic] bowler's maximum natural force through the bowler's finger pad inserted in a bowling ball finger hole, in lifting and rotating the bowling ball at its release, comprising,

a) a finger pad shield with an open end adapted for insertion of a finger pad on said finger pad shield; said finger pad shield including a contact area located proximate said open end and adapted to receive a finger pad in said contact area; and wherein,

b) said finger pad shield is substantially rigid to resist deformation from a force produced when a maximum natural force is applied through a finger hole of said bowling ball, to lift and rotate said bowling ball at its release, and to spread said force produced, over said contact area.

42. The bowler's aid of claim 40, wherein, said maximum natural force is in a range within the limit of muscular skeletal development.

43. The bowler's aid of claim 40, wherein said finger pad shield is adapted to spread said force produced over said contact area, substantially uniformly.

49. The bowler's aid

[which comprises:

a bowler's finger pad shield for protecting a bowlers finger pad when inserted into a bowling ball finger hole, from the force produced when lifting the bowling ball to apply spin or rotation at its release, comprising,

- a) means for forming a contact area with a finger pad;
- b) means for holding a finger pad in a fixed position with said means for forming a contact area and in a fixed position with a contact area formed with said means for forming a contact area with a finger pad;
- b) [sic c)] said means for forming a contact area with a finger pad including means for spreading a force produced when applying lift to said bowling ball, at its release, over said contact area,]

wherein said means for spreading a force includes means for resisting deformation.

*The prior art*

The Examiner relies on the following prior art references to show unpatentability:

Fowble	U.S. 617,929	Jan. 17, 1899
Pratt	U.S. 5,881,388	Mar. 16, 1999

*The issues*

A. The Examiner rejected claims 40-45 under 35 U.S.C. § 112, second paragraph as being indefinite (Ans. 2-3).

B. The Examiner rejected claims 33, 34, 36, 38-43, and 45-58 under 35 U.S.C. § 102(b) as being anticipated by Fowble (Ans. 3-5).

C. The Examiner rejected claims 35, 37, 44, and 57 under 35 U.S.C. § 103(a) as being obvious over Fowble and Pratt (Ans. 5).

*A. 35 U.S.C. § 112, second paragraph*

The Examiner finds that “the scope of ‘maximum natural force’ is indefinite. The term maximum relates to the intended use, by the strength of

an individual, by the delivery of the ball and the weight of the ball. Such a variable is subjective” (Ans. 2).

Appellants contend that “[m]aximum natural force’ is defined in the application with reference to a definite standard. Applicants['] recitation of ‘maximum natural force’ is accurate anatomically, as circumscribed by the range of muscular skeletal development and the conventional weight of a bowling ball, as stated by Dr. W. Robert Addington, D.O. in the Rule 132 Declaration” (App. Br. 13).

In view of these conflicting positions, we frame the definiteness issue before us as follows:

Did the Examiner err in finding that the phrase “maximum natural force” as used in claims 40 and 42 is indefinite?

*Findings of Fact (FF)*

1. The Specification teaches that the “finger pad shield 14, opposed to, in contact with the bowler's finger pad 16 places a rigid surface between the force of the bowling ball against the finger pad 16 and spreads that force, when the bowler's maximum natural force is applied to the bowling ball at the moment of release” (Spec. 23, ll. 16-19).
2. The Specification teaches that the “force which the rigid finger pad 14 resist[s] is within a range limited by the conventional limit of bowling ball weights and the limit of muscular skeletal development” (Spec. 23, ll. 28-30).
3. The Specification teaches that “a bowler will choose a ball suitable to that bowler’s muscular skeletal development and within the range

of weight allowed by bowling authorities such as the American Bowling Congress” (Spec. 23, l. 30 to 24, l. 2).

4. The Addington Declaration states that the “force produced by the release of the [bowling] ball . . . is within a defined range. That range is [drawn to]. . . a maximum substantially limited to a bowler within a maximum of muscular skeletal development bowling with [a] ball as prescribed by conventional bowling conventions” (Addington Dec. ¶ 3).

5. The Addington Declaration states that the “maximum of muscular skeletal development is determinable and objectively measurable inductively from knowledge of anatomy” (Addington Dec. ¶ 4).

#### *Principles of Law*

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

The Federal Circuit has stated that “[w]hen a word of degree is used . . . the patent's specification [must] provide[ ] some standard for measuring that degree’ to be definite.” *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1372 (Fed. Cir. 2008) (quoting *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1351 (Fed. Cir. 2005)).

#### *Analysis*

The Specification describes “maximum natural force” in the context of claims 40 and 42 as the force applied to a bowling ball by a bowler (FF 1-2). The Specification notes that maximum bowling ball weights are set (FF

3). The Specification also refers to upper limits of “muscular skeletal development” (FF 1-3). The Addington Declaration states that the “maximum of muscular skeletal development is determinable and objectively measurable inductively from knowledge of anatomy” (Addington Dec. ¶ 4; FF 4-5).

While the phrase “maximum natural force” is a matter of degree, the Specification and Addington Declaration evidence measurement standards which provide the ordinary practitioner with guidance on determining the metes and bounds of “maximum natural force.”

The maximum bowling ball weight is clearly set (FF 3), leaving only the issue of whether maximum muscular strength is determinable. The Addington Declaration states, without evidentiary contradiction in the Answer, that maximum muscular strength is a determinable value (FF 4-5).

We therefore agree with Appellants that the Specification and knowledge of the ordinary artisan provide sufficient information regarding the phrase “maximum natural force” to satisfy the definiteness requirement.

#### *Conclusion of Law*

The Examiner erred in finding that the phrase “maximum natural force” as used in claims 40 and 42 is indefinite.

#### *B. 35 U.S.C. § 102(b) over Fowble*

The Examiner rejected claims 33, 34, 36, 38-43, and 45-58 under 35 U.S.C. § 102(b) as being anticipated by Fowble (Ans. 3-5).

The Examiner finds that “[l]ike appellant's invention, Fowble is limited to a finger protector to protect the finger. Fowble describes the protector being of sufficient length to cover the entire finger, including the



finger pad . . . Fowble discloses the material may be made ‘more rigid,’ to protect the finger from the task that a user is performing” (Ans. 8).

Appellants contend that “any reference to Fowble disclosing a ‘shield made of rigid material,’ is not supported by record based facts, fails the Examination Standard of Substantial Evidence, and is meaningless in the context of the record claims” (App. Br. 16). Appellants contend that

Fowble's disclosure has no teaching or suggestion or disclosure of the structure of the material used in the disclosed protector. Fowble makes no disclosure of any “raised surface,” or “limit means[”] for limiting the depth of insertion of the finger pad shield into the finger hole of a bowling ball. The disclosure of Fowble of what Examiner identifies as “strap 5,” is nothing more than a part of the protector, as described above.

(App. Br. 17.)

In view of these conflicting positions, we frame the anticipation issue before us as follows:

Did the Examiner err in finding that Fowble teaches a finger pad which satisfies the claim limitations?

*Findings of Fact*

6. Fowble teaches to “construct a finger shield or protector . . . [with] a thicker and more rigid material than heretofore employed without in any manner interfering with the bending of the finger” (Fowble, col. 1, ll. 34-37). Fowble is concerned with materials to protect “bricklayers” and “stonemasons” (Fowble, col. 1, ll. 10-11).

7. Fowble teaches finger pads as described in Figures 2 and 4 reproduced below:

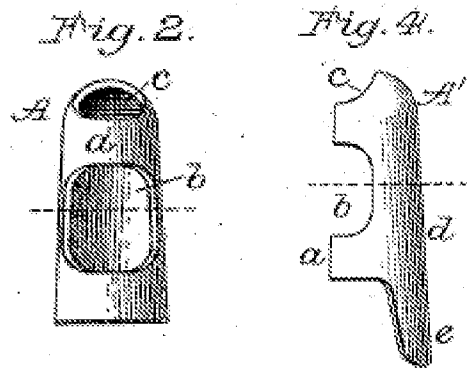


Figure 2 is said to show “a finger protector or shield” (Fowble, col. 2, ll. 53-54). Figure 4 is said to show “a finger shield or protector . . . having an extension at its lower front portion for affording protection to the finger beyond the second joint” (Fowble, col. 2, ll. 56-59).

8. Fowble discloses a finger shield with an open end which comprises first and second surfaces, opposed to one another, and extending from the open end with the first surface comprising a “contact area” (see FF 7).

9. Fowble discloses an element “a” in figure 2 which functions to hold the finger to the finger shield (see FF 7).

10. Fowble teaches a “vulcanized india-rubber of a sufficient degree of hardness to properly withstand the wear incident to the handling of brick, stone, or other material used in building operations” (Fowble, col. 2, ll. 63-67).

11. The Examiner finds that the “shield of the prior art is inherently capable of resisting deformation from a force of a bowling ball during such an intended use” (Ans. 4).

12. The Examiner finds that “the at least one fastener is a strap [a]s shown by elements ‘a’ and ‘d’ of Fowble which are a ‘strap’. By the

Merriam Webster's definition of a 'ring' as a ': a circular band for holding, connecting, hanging, pulling, packing, or sealing[']', elements 'a' and 'd' meet this limitation" (Ans. 10).

*Principles of Law*

"Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims .... The second step in the analyses requires a comparison of the properly construed claim to the prior art." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

During prosecution, claims are given the broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Claims will be given their plain meaning unless their plain meaning is inconsistent with the Specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim ...." *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986).

Claim terms are interpreted using the broadest reasonable interpretation in light of the Specification. *See, e.g., In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000) ("[D]uring examination proceedings, claims are

given their broadest reasonable interpretation consistent with the specification.”). *Also see In re Morris*, 127 F.3d 1048, 1054-56 (Fed. Cir. 1997) (“Absent an express definition in their specification, the fact that appellants can point to definitions or usages that conform to their interpretation does not make the PTO's definition unreasonable when the PTO can point to other sources that support its interpretation.”).

“It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997).

#### *Analysis*

Fowble describes a finger pad shield which comprises an open end that permits insertion of a finger pad with a first and second surface opposed to one another, where the finger pad shield includes an element “a” in figure 2 which functions to hold the finger to the finger shield (Ans. 3-4; FF 6-9). Fowble teaches that the finger pad shield comprises “a thicker and more rigid material” (FF 6). In sum, Fowble teaches all of the structural elements of independent claims 33 and 40. *See Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) (“[I]n order to demonstrate anticipation, the proponent must show ‘that the four corners of a single, prior art document describe every element of the claimed invention.’” (citations omitted)).

*Claims 40-42*

We are not persuaded by Appellants' argument regarding claim 40 that "any reference to Fowble disclosing a 'shield made of rigid material,' is not supported by record based facts" (App. Br. 16).

In fact, Fowble expressly teaches to "construct a finger shield or protector . . . [with] a thicker and more rigid material than heretofore employed without in any manner interfering with the bending of the finger" (Fowble, col. 1, ll. 34-37; FF 6). Fowble is concerned with materials to protect "bricklayers" and "stonemasons" (Fowble, col. 1, ll. 10-11; FF 6). We think Fowble's teaching of a "vulcanized india-rubber of sufficient degree of hardness to properly withstand the wear incident to the handling of brick, stone or other material used in building operations" may reasonably be broadly interpreted as satisfying the requirement for a shield "that is substantially rigid" in claim 40 (*see* FF 10).

Appellants have failed to demonstrate any specific structural difference imposed by the "rigid to resist deformation" language of claim 40 and the level of rigidity would differ depending upon whether a young child was knocking the pins down with an eight pound ball or her parent was lofting the ball into the gutter with a sixteen pound ball.

Appellants have also failed to demonstrate that the functional recitation of "maximum natural force" alters the structure of the resulting device such that the Fowble finger pad shield does not inherently anticipate the limitations of claims 41 and 42.<sup>2</sup>

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<sup>2</sup> We need not rely upon the references relied upon by the Examiner in the paper mailed January 29, 2008.

As in *Schreiber*, the Examiner has shifted the burden to Appellants “to show that the prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus.” *See* FF 11; *Schreiber*, 128 F.3d at 1478. *See also In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (“Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.”).

*Claim 33*

We also do not find persuasive Appellants’ argument regarding claim 33 that “there is no disclosure beyond that limited disclosure of a strap or ring or any other means to hold the protector in a ‘fixed’ or any other intended relationship with the finger” (App. Br. 16). In fact, the strap or ring disclosed by Fowble in figure 2 functions to retain the finger within the finger pad shield since without the ring, the finger pad shield would fall off the finger (*see* FF 7). While Appellants argue that the “Fowble protector is disclosed as a loose fitting device, worn with enough clearance between the protector and the finger to allow sand and grit to accumulate and fall out” (App. Br. 17), claim 33 does not require any specific level of “fit,” only a “fixed relationship.” The Fowble protector holds the finger pad in a particular “fixed relationship” (*see* FF 7, 9).

We also are not persuaded by Appellants’ argument that the “Examiner selectively chose to disregard the recited claim as a whole” (App. Br. 19). In fact, the Examiner addressed all of the structural and functional

requirements of claim 33 (*see* Ans. 3-4). Claim 33 has a number of functional recitations, including the requirement that the force of bowling “is spread over said contact area,” which the Examiner found were inherently satisfied by the finger pad shield of Fowble (Ans. 3-4). The Examiner properly shifted the burden to Appellants “to show that the prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus.” *See Schreiber*, 128 F.3d at 1478.

*Claims 38, 39, 45, and 53*

Appellants contend that Fowble does not teach a “‘raised surface,’ or ‘limit means,[’] for limiting the depth of insertion of the finger pad shield into the finger hole of a bowling ball” (App. Br. 16-17).

The Examiner finds that in “Fowble, element ‘a’ is a raised surface from surface b and inherently acts to contact the . . . bowling ball and to limit the depth the finger protector can be placed in a hole” (Ans. 8).

We agree with Appellants that the Examiner has not demonstrated that element “a” is “raised” as required by claim 38. Even under the broadest reasonable interpretation rubric, an element that does not extend beyond a surface of the finger protector cannot reasonably be interpreted as “raised.”

We reverse the rejection of claims 38, 39, 45, and 53.

*Claims 34 and 36*

We are not persuaded by Appellants’ argument that “part ‘a’ of Fowble has not been shown by Examiner as meeting the combined recitations of . . . claim 34 and 36 respectively” (App. Br. 20). Claims 34 and 36 require that the fastener is a strap or ring, respectively. The Examiner reasonably finds that “the at least one fastener is a strap [a]s

shown by elements ‘a’ and ‘d’ of Fowble which are a ‘strap’. By the Merriam Webster's definition of a ‘ring’ as a ‘: a circular band for holding, connecting, hanging, pulling, packing, or sealing[’], elements ‘a’ and ‘d’ meet this limitation” (Ans. 10; FF 12). We agree with the Examiner that Fowble reasonably teaches a “circular” region which holds the finger pad shield onto a finger and satisfies the “strap” and “ring” limitations of claims 34 and 36 (FF 7, 12).

*Claims 43, 46-48, 51, 54-56, and 58*

Claims 43, 46-48, 51, 54-56, and 58 have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Claim 43 is representative.

Appellants contend that the Examiner failed “to set forth the specific elements in Fowble which match the recited claim elements” (App. Br. 24). The specific limitation at issue is that the “finger pad shield is adapted to spread said force produced over said contact area, substantially uniformly” (Claim 43). We are not persuaded, since the Examiner reasonably finds that

Fowble inherently is capable of spreading a force uniformly over a contact area . . . Fowble shows the function of placing a finger in the shield and having forces exerted between a users finger and the shield be the result of performing a task. These forces between the finger and the shield “form a contact area”, “spread force produced” during the task (as recited in claims 46, 48 and 51), spread the for[c]e “uniformly” (claim 47).

(Ans. 4.)

As in *Schreiber*, the Examiner has shifted the burden to Appellants “to show that the prior art structure did not inherently possess the functionally defined limitations of his claimed apparatus.” See FF 11; *Schreiber*, 128



F.3d at 1478. *See also In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) (“Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product.”).

*Claims 49, 50, 52, and 56*

Claims 49, 50, 52, and 56 have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Claim 49 is representative.

Appellants contend that Fowble “does not meet the requirement set forth in the MPEP for showing inherency” (App. Br. 23). We are unpersuaded by this arguments for the reasons discussed above with regard to claim 40.

*Conclusions of Law*

The Examiner erred in finding that Fowble teaches a finger pad shield with a “raised surface” of claims 38, 39, 45, and 53.

The Examiner did not err in finding that Fowble teaches a finger pad shield which satisfies the limitations of claims 33, 34, 36, 40-43, 46-52, 54-56, and 58.

*C. 35 U.S.C. § 103(a) over Fowble and Pratt*

The Examiner rejected claims 35, 37, 44, and 57 under 35 U.S.C. § 103(a) as being obvious over Fowble and Pratt (Ans. 5).

The Examiner finds that

Pratt shows combining finger inserts with gloves in order to combine the benefits of the insert with those of a gloved hand. To have

included the insert of Fowble in a glove would have been obvious in order to protect the finger as well as the hand as a result of the benefits of the glove.

(Ans. 5.)

Appellants contend that

There is no teaching or suggestion in Fowble or Pratt of combining the flexible inserts of Pratt into the protector of Fowble intended to be of vulcanized rubber to resist the lateral chaffing or galling forces, along the finger surface. Pratt's inserts are flexible to be tactile responsive to the feel of coins in response to the force of the finger against the coins.

(App. Br. 26.)

In view of these conflicting positions, we frame the obviousness issue before us as follows:

Did the Examiner err in finding that the combination of Fowble and Pratt render obvious a finger pad shield “wherein said fastener is an enclosure for a finger and said finger pad shield is attached to said enclosure”?

*Findings of Fact*

13. Pratt teaches a “lightweight glove having finger grip inserts” (Pratt, col. 1, l. 5).

14. Pratt teaches that “[i]t would be a benefit . . . to have a glove that could be worn while playing to protect the hands and fingers from contamination” (Pratt, col. 1, ll. 38-40).

*Principles of Law*

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art;

(2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of nonobviousness, if any. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The Supreme Court has recently emphasized that “the [obviousness] analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, \_\_\_, 127 S. Ct. 1727, 1741 (2007).

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at \_\_\_, 127 S. Ct. at 1739. “If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at \_\_\_, 127 S. Ct. at 1740. Moreover, an “[e]xpress suggestion to substitute one equivalent for another need not be present to render such substitution obvious.” *In re Fout*, 675 F.2d 297, 301 (CCPA 1982). As noted by the Court in *KSR*, “[a] person of ordinary skill is also a person of ordinary creativity, not an automaton.” 550 U.S. at \_\_\_, 127 S. Ct. at 1742.

#### *Analysis*

Claims 35, 37, 44, and 57 have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Claim 37 is representative.

Fowble teaches a finger pad shield (FF 6-12). Pratt teaches placement of finger pads into a glove (FF 13-14).

Applying the *KSR* standard of obviousness to the claims and the findings of fact, the ordinary practitioner would have recognized that it

would have been obvious to insert the finger pad shield of Fowble into the glove of Pratt so that the bricklayers and stonemasons could protect their hands from contamination as taught by Pratt (FF 14) while also protecting their hands from damage by bricks and stones (FF 6, 10). Given the disclosure of Fowble of a finger pad shield and Pratt of a glove to enclose finger pad shields, inserting the finger pad shield of Fowble into the glove of Pratt is a “predictable use of prior art elements according to their established functions.” *KSR*, 550 U.S. at \_\_\_, 127 S. Ct. at 1740.

We are also not persuaded by Appellants’ argument that “Pratt teaches away from a rigid insert . . . as the glove tips must be tactile [sic] resilient so the user can feel coins” (App. Br. 24). However, Pratt never discusses that the user must be able to feel coins (*see* portion cited by Appellants, Pratt, col. 2, ll. 1-26). “We will not read into a reference a teaching away . . . where no such language exists.” *DyStar Textilfarben GmbH & Co.*

*Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1364 (Fed. Cir. 2006).

#### *Conclusions of Law*

The Examiner did not err in finding that the combination of Fowble and Pratt render obvious a finger pad shield “wherein said fastener is an enclosure for a finger and said finger pad shield is attached to said enclosure.”

#### SUMMARY

In summary, we reverse the rejection of claims 40-45 U.S.C. § 112, second paragraph as being indefinite.

We reverse the rejection of claims 38, 39, 45, and 53 under 35 U.S.C. § 102(b) as being anticipated by Fowble.

We affirm the rejection of claims 33, 34, 36, 40-44, 46-52, and 54-58 under 35 U.S.C. § 102(b) as being anticipated by Fowble. We also affirm the rejection of claims 35, 37, 44, and 57 under 35 U.S.C. § 103(a) as being obvious over Fowble and Pratt.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED-IN-PART

cde

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